

## **REMARKS**

Claims 18-20 have been canceled without prejudice or disclaimer as to the subject matter recited therein. Claims 1-17 remain pending in the captioned case. Further examination and reconsideration of the presently claimed application are respectfully requested.

### **Allowed Claims**

The undersigned appreciates the Examiner's indication that claims 1-6, 8, and 9 are allowable over the prior art of record. However, for reasons set forth below, Applicant also believes that the remaining claims 7 and 10-17 are also allowable.

### **Section 112 Rejection**

Claims 7 and 10-17 were rejected under 35 U.S.C. § 112, first paragraph. The Office Action alleges that the originally filed specification does not have support for certain limitations placed in claims 7 and 10, previously amended on June 25, 2003. Applicant respectfully disagrees.

The Office Action alleges there was no original support for the phrase "moves precisely the width of a die configured on the wafer from the die to each of all neighboring die across the entire wafer." See claims 7 and 10. Upon reading the specification as originally filed more closely, the undersigned wishes to point out at least four instances in which support is given to the recited terminology above. First, reference is made to passages which begin on page 7, line 15 and end on page 9, line 4. Specifically, a three-dimensional translational mechanism is described to allow movement of a wafer in three independent directions (Specification -- pg. 7, lines 15-17). The wafer can be moved in an up-and-down direction (z-plane) and can also be incrementally stepped in a "predetermined distance in the xy-plane." (Specification -- pg. 7, lines 19-20.)

Connected to the translational mechanism 70 is a motor wherein mechanism 70 is situated in a "home position on the wafer above a given integrated circuit." (Specification -- pg. 7, lines 26-28.) If the mechanism 70 is to move precisely from one set of probe pads on one die to another "corresponding" set of probe pads on another die, mechanism 70 must move a predetermined distance across the wafer in a step-and-repeat fashion from die-to-die (Specification -- pg. 7, line 28 - pg. 8, line 1). To do so, "the

dimensions of each die are entered into the motor connected to mechanism 70.” (Specification -- pg. 8, lines 9-10.) “Thereafter, the automated probing can take place, beginning at the home position and incrementing the pre-measured distance across the wafer to the next integrated circuit . . .” (Specification -- pg. 8, lines 13-14.) “This is repeated automatically between each integrated circuit across the entire wafer . . .” (Specification -- pg. 8, lines 17-18, emphasis added.)

In order to test one die and then automatically test the neighboring die in a step-and-repeat fashion, the probe needle must move precisely from one set of bonding pads on the first die to another set of bonding pads on the neighboring die. If the wafer holding mechanism does not move precisely the width of the die, then when the probe needles are moved to the neighboring die, they will not contact the appropriate bonding pads on that die. Absent precise movement, automated testing cannot be achieved in a step-and-repeat fashion as originally claimed and presented in the originally filed specification. Moreover, the original specification also describes the step-and-repeat fashion in which movement must occur precisely the width of one die in the x and y directions in the “Summary of the Invention” on page 4, lines 15-21.

For at least the reasons stated above, Applicant believes there is more than adequate support for the previous amendment and the subject matter added to claims 7 and 10. Moreover, it is well recognized that Applicant need not use the exact language of the specification, but that “rewording of a passage where the same meaning remains intact is permissible.” MPEP 2163.07; *In re Anderson*, 471 F.2d 1237 (CCPA 1973). It is also permissible under the Patent Act that the written specification need only require “sufficient description to show one of skill in the . . . art that the inventor possessed the claimed invention at the time of filing.” *See* MPEP 2163.05, last sentence; 35 U.S.C. § 112, first paragraph. “By disclosing in a patent application a device that inherently performs a function or has a property, operates according to a theory, or has an advantage, a patent application necessarily discloses that function, theory, or advantage even though it says nothing explicit concerning it.” MPEP 2163.07(a); *In re Reynolds*, 442 F.2d 384 (CCPA 1971).

While the specification does not explicitly call out the word “precisely,” the specification nonetheless describes the steps needed to move a wafer from one die to another in a step-and-repeat fashion. In order to test neighboring die, it is therefore clearly inherent that the amount by which the wafer moves would be precisely the width of that die. In addition to calling out a “pre-measured distance across the wafer to the next integrated circuit” (Specification -- pg. 8, lines 13-14), the present

specification also explicitly describes the repeated movement from one die to another die "across the entire wafer." (Specification -- pg. 8, lines 18-19.)

Accordingly, Applicant respectfully traverses this objection and respectfully requests its removal.

### **Section 102 Rejection**

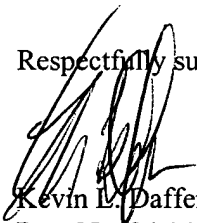
Claims 18-20 were rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,493,236 to Ishii et al. In light of the cancellation of claims 18-20, Applicant believes this rejection has been rendered moot in its entirety.

### **CONCLUSION**

This response constitutes a complete response to the issues raised in the Office Action mailed August 19, 2003. In view of remarks traversing the objections and rejections presented therein, Applicant asserts that claims 1-17 are in condition for allowance. If the Examiner has any questions, comments, or suggestions, the undersigned attorney earnestly requests a telephone conference.

No fees are required for filing this amendment; however, the Commissioner is authorized to charge any additional fees which may be required, or credit any overpayment, to LSI Logic Corp. Deposit Account No. 12-2252/01-006.

Respectfully submitted,

  
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